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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
U02-0216.040

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Name_____

Application Number	Filed
10/604,394	July 17, 2003

First Named Inventor
Nadi Sakir Findikli

Art Unit	Examiner
2683	Stephen M. D'Agosta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.7.1. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,329.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34_____

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January 30, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed applicable form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REMARKS IN SUPPORT OF PRE-APPEAL BRIEF

Applicant submits that the current and immediately preceding office actions issued by the Examiner in the present application contain clear errors in the Examiner's rejections as well as omissions of one or more essential elements needed for a prima facie rejection.

The Examiner has rejected claims 1-3, 8-10, 14, 17-21, 25-31, 35-44, 49, 50-52, and 56 under 35 USC 102(b) as being anticipated by Blow (WO99/53621). The Examiner has also rejected claims 4-5, 7, 11-13, 15-16, 22-23, 32-33, 45-46, 48, 53-55, and 57-58 under 35 USC 103(a) as being unpatentable over Blow (WO99/53621) without a secondary reference.

It is Applicant's belief that the Examiner has extended the teachings of Blow beyond the text of the reference. The present invention provides additional steps, processes, and detail that are not contemplated by Blow. For instance, Blow does not teach the complexities involved in the recited claim element of: "*exchanging data between the mobile phone accessory, the data pertaining to software resident on the mobile phone accessory and the ability of the mobile phone to download and execute the software, wherein the data is used to determine what software to transfer from the mobile phone accessory to the mobile phone*".

The clause above is included in each independent claim of the present invention. It is directed toward determining whether the mobile phone would even be capable of interacting with the accessory assuming the software could subsequently be downloaded and verified (authenticated). This includes things like whether the mobile phone has the underlying software and hardware requirements necessary to execute the incoming software associated with the accessory. Support for this construction is found in paragraphs [0010], [0012], and [0015] of the present application.

The Examiner has "interpreted" the 'VALID ACCESSORY' block of Figure 2, step 204 in Blow as requiring a check of either the characteristics or capabilities of the phone. This is simply not true. Blow is quite clear that 'valid accessory' means only one which authenticates properly (see, p. 7, ln. 30). The Examiner's interpretation clearly exceeds the scope of Blow's teachings and is an improper extension of the plain language

of Blow. The term "valid accessory" is not given any meaningful definition or description in Blow. Moreover, Blow's process yields a result of 'presumed valid' (see, p.5, ln. 25) not a result of actually valid. This is because Blow performs only a single authentication procedure of comparing a secret code shared by the mobile phone and the accessory or, a public key / private key authentication process. All Blow does is ensure that the mobile phone and the accessory contain a key/lock pairing that matches. Any authentication or verification beyond that stated above is beyond the scope of Blow. The Examiner has stretched Blow beyond its reasonable limits to read on clauses in the claims of the present invention such as "ensuring the mobile phone is capable of receiving software ..." and "ensuring the mobile phone accessory is capable of transferring software...". Neither of these concepts is taught nor disclosed by Blow.

The present invention performs additional operations to ensure the operability such as analyzing the hardware and software functional capabilities of the mobile phone to determine whether the accessory can operate with the mobile phone even if authenticated. The present invention will also determine which version of software (if multiple are available) is best suited for the specific mobile phone to be paired with the accessory. (see, ¶ [0015] of specification). Blow simply does not describe any processes or methods that determine a mobile phone's capabilities prior to a download. Blow assumes that the mobile phone is capable and focuses its efforts on authenticating or verifying a code to enable a transfer. An accessory can be valid according to Blow but that does not necessarily mean that it is suited to the mobile phone. The mobile phone may not have enough processing power to operate some of the features of the accessory. Or, the mobile phone may not possess some of the user interface features (e.g., full keypad) that would provide the full benefit of the accessory.

Even in the authentication aspect, Blow is not as thorough as the present invention since authentication in Blow is in one direction while the authentication claimed by the present invention is bi-directional meaning that the phone is verified as a receiver of software and the accessory is verified as a transfer-er of software.

Blow's teachings stop once the software has been downloaded error free to the mobile phone. There is no process of verifying that the downloaded software itself is licensed for use on the mobile phone, certified for use on the mobile phone (e.g., on a list

of approved software), or been tampered with from its original incarnation. The Examiner relies too heavily on "Official Notice" as a means for rejecting the claim language without attempting to deal with the specifics involved in verifying licenses, certifications, and tampering. The Examiner has understated the significance and relevance of software piracy and the efforts to ensure that pirated software can not be executed to control the interaction between the mobile phone and accessory.

As per MPEP § 2144.03, official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. (*In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)). It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

It is also noteworthy that the Examiner has decided that "official notice" is sufficient to reject the claims that involve license checking, certification, and encryption using Blow's secret code authentication procedure but that official notice is not sufficient to read on whether the software has been tampered with since the Examiner saw fit to introduce a secondary reference to address tampering. It is applicant's belief that the Examiner has exceeded the scope of his discretion by broadly invoking 'official notice' when the facts are not believed to be so well known as to be capable of instant and unquestionable demonstration.

In sum, Blow teaches downloading software from an accessory to a mobile phone once an optional authentication of the accessory occurs. Verification of the downloaded software involves checking for errors only to the extent that all of the bytes arrived in the proper order such that the software can be executed by the mobile phone. There is no attempt to verify the software itself as being authorized for operation on the mobile phone.

The present invention is much more complex in that both the mobile phone and the accessory are subjected to multiple authentication and verification procedures prior to and following download. Determinations are initially made whether the mobile phone is capable of even accommodating the accessory. Software is downloaded (encryption is

optional) to the mobile phone where it is checked against licenses, certifications, and tampering prior to execution.

Blow does not teach "*exchanging data between the mobile phone accessory, the data pertaining to software resident on the mobile phone accessory and the ability of the mobile phone to download and execute the software, wherein the data is used to determine what software to transfer from the mobile phone accessory to the mobile phone*" because Blow never contemplates that there is more than one version of software that could be transmitted. Moreover, Blow does not teach "ensuring the mobile phone is capable of receiving software through the communication link" and "ensuring the mobile phone accessory is capable of transferring software through the communication link".

The Examiner has relied on Blow's 'authentication' procedure as reading on the above cited clauses of the claims. Applicant believes this to be in error since Blow only describes matching a secret code between mobile phone and accessory and not once throughout the entire disclosure discusses **what** has been authenticated. The secret code procedure of Blow merely describes **how** not what has been authenticated. The term software license is never mentioned in Blow at all. Nor is there anything alluding to the functional capabilities of the phone to actually handle the accessory. Blow is solely directed toward recognizing that memory is scarce on a mobile phone and pre-loading software for all possible accessories the mobile phone can handle is not something that could be done.

Ironically, Blow does not bother to verify whether the mobile phone itself has enough current memory capacity to store the proposed downloaded software from the accessory. Once authenticated, the mobile phone will simply begin downloading. It is entirely possible that the mobile phone will run out memory before completing the download causing the download to fail. The present invention would not allow such a scenario because it performs a functional check prior to download to ensure the mobile phone has enough memory to accommodate the incoming software.

Thus, Blow fails to teach all of the recited elements and steps of the present invention either alone or in combination. Applicant requests reconsideration and withdrawal of the 35 USC 102(b) and 35 USC 103(a) rejections of claims 1-58.

Respectfully submitted,

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